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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,356	01/13/2004	Yulii Aleksandrovich Labas	CLON-090	3335

24353 7590 02/28/2007  
BOZICEVIC, FIELD & FRANCIS LLP  
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EXAMINER
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MONTANARI, DAVID A

ART UNIT	PAPER NUMBER
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1632

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/757,356

Applicant(s)

LABAS ET AL.

Examiner

David Montanari

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,9-11 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,9-11 and 19-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicants arguments and amendments filed 8/25/2006 have been entered.
2. A new examiner has taken over prosecution of the instant application.
3. Claims 3-8 and 12-18 are cancelled.
4. Claims 1, 2, 9-11 and 19 amended.
5. Claims 20-24 are newly added.
6. Claims 1, 2, 9-11 and 19-24 are examined in the instant application.

### ***Specification***

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (page 47, line 17). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Appropriate correction is required.

### ***Response to Arguments***

Applicants argue in amendment filed 10/25/2006 that the instant specification has been amended to delete "http://". However this is not persuasive. A link to a website still exists in the instant specification. This is not permissible under MPEP § 608.01, and the entire link must be deleted from the instant specification. The objection is maintained.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 9-11 and 19 and new claims 20-24 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for:

An isolated nucleic acid comprising SEQ ID NO:17, wherein said nucleic acid encodes a functional fluorescent protein; a construct comprising a vector and said nucleic acid; an expression cassette comprising said nucleic acid; a host cell comprising said expression cassette; and a kit comprising said nucleic acid, does not reasonably provide enablement for:

A nucleic acid that has a sequence identity of at least 95% with SEQ ID NO:17, a construct comprising a vector and said nucleic acid; an expression cassette comprising said nucleic acid; a host cell comprising said expression cassette; and a kit comprising said nucleic acid for reasons of record in the office action mailed 5/3/2006.

Claims 1, 2, 9-11, 19 and new claims 20-24 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for reasons of record in the office action mailed 5/3/2006.

***Response to Arguments***

Applicants argue in amendment filed 10/25/2006 that in the spirit of expediting the prosecution the claims have been amended to remove the objectionable language and to recite that the claimed nucleic acid has a sequence identity of at least 95% with SEQ ID NO: 17. Further applicant argues that the amendment to the claims provides the structure and function for the claimed nucleic acids. This is not persuasive. As discussed in the previous office action it is not known what parts of the nucleotide sequence of SEQ ID NO: 17 encodes a chromo or fluorescent protein. SEQ ID NO: 17 is 1066 nucleotides in length leaving the skilled artisan with 53 nucleotides in variability that can adversely affect the protein encoded by any 95% of SEQ ID NO: 17, resulting in a protein that does not encode a chromo or fluorescent protein. Applicants have discovered a new protein, however, the instant specification is silent with regard to teaching the skilled artisan the structure of the protein encoded by the claimed nucleic acids. The instant claim 2, which claims an isolated nucleic acid that is encoded by SEQ ID NO: 17 would be more along allowable subject matter, should the claim become allowable.

No claims are allowed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Montanari whose telephone number is 1-571-272-3108. The examiner can normally be reached on M-Tr 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on 1-571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SUMESH KAUSHAL, PH.D.  
PRIMARY EXAMINER